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No. 299

In the Supreme Court of the United States

OCTOBER TERM, 1968

ERWIN-NEWMAN COMPANY, PETITIONER

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

ERWIN N. GRISWOLD,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

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MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

1. Petitioner filed this action in the United States Court of Claims under 28 U.S.C. 1498 to recover compensation for the government's use of structures covered by U.S. Patent No. 2,687,102, entitled "Truss Support" (Pet. App. 6a).[1]

The subject matter disclosed in petitioner's patent is a stationary structure for supporting a roof, described as useful in aircraft hangar construction, and for the support of building roofs, bridge structures, and the like (Pet. App. 6a). The basic elements of

[1] "Pet. App." refers to the appendix to the petition for a writ of certiorari. "Tr." refers to the transcript of evidence, a copy of which has been lodged with the Clerk.

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the claim are (1) a vertical supporting means; (2) a truss which is cantilevered (projects outwards) from the vertical supporting means; (3) a rigid means which suspends the truss from the vertical supporting means; and (4) a section of the truss extending beyond the point where the suspending member is connected (Pet. App. 7a). The alleged novel feature of the claim is that the rigid means is designed to resist compression as well as tension (Pet. App. 13a).

The Court of Claims, adopting the Trial Commissioner's opinion, findings of fact, and recommended conclusions of law, dismissed the action (Pet. App. 5a). It found that the claimed invention "would have been obvious to a structural engineer of ordinary skill at the time the invention was made," and that it, therefore, was not patentable under 35 U.S.C. 103 (Pet. App. 9a).

2. Contrary to petitioner's assertion (*e.g.*, Pet. 11), the Court of Claims followed the standards for determining obviousness under 35 U.S.C. 103 as enunciated by this Court in *Graham* v. *John Deere Company,* 383 U.S. 1, and *United States* v. *Adams,* 383 U.S. 39. The court expressly noted that the application of 35 U.S.C. 103 requires the determination of (1) "The scope and content of the prior art"; (2) "Differences between the prior art and the claims at issue"; and (3) "The level of ordinary skill in the pertinent art" (Pet. App. 6a).[2] The court's deter-

[2] Although the court did not specifically cite the *John Deere* or *Adams* decisions, it did cite *Martin-Marietta Corp.* v. *United States*, 373 F. 2d 972, where it had quoted these standards from the *John Deere* opinion (Pet. App. 6a).

mination of those elements in the instant case was correct,[3] and presents no question warranting further review.[4]

[3] The court's examination of the prior art revealed suspended cantilever aircraft hangar roofs having a rigid suspending member capable of withstanding both compression and tension (Pet. App. 15a–18a). The court stated that the differences between petitioner's structure and prior art publications illustrating hangar designs were "small" (Pet. App. 8a). The novelty in petitioner's claim, it found, was limited to the specific teaching that the rigid suspending member was designed to withstand compressive forces (*ibid.*).

The court also determined the level of ordinary skill in the pertinent art, *i.e.*, structural design. It noted (1) that a structural engineer can routinely design a structure for use in a particular environment on the basis of a line drawing which shows the space to be enclosed by the structure and the relative disposition of the structural members; and (2) that a line drawing for a suspended cantilever truss system had been shown in the March 1952 issue of the Architectural Forum (Pet. App. 8a). The court found that, on the basis of such a line drawing, an engineer could select design loading conditions by means of a routine stress analysis using sources such as building codes, design manuals and engineering experience, and that he could size the various members according to the loads they must carry (Pet. App. 8a–9a). One of the inventors, Erwin, testified that he followed this procedure in designing petitioner's structure (Tr. 822–832). The court concluded that a structural engineer of ordinary skill could design a suspending member which would resist compression as well as tension where the stress analysis indicated, as it did in this case, the existence of loading conditions which required that such forces be overcome (Pet. App. 8a–9a). The court specifically noted that such "reversible" stress members are well known in the design of aircraft and bridge structures (Findings 19–20) (Pet. App. 9a, 16a). The analogy between aircraft wing and hangar roof designs was acknowledged at trial by one of petitioner's own witnesses (see Tr. 78).

[4] The record shows that while suspended cantilever roof structures for airplane hangars were publicly known for many years, it was not until 1951–1952 that a need actually arose to build such

The petition for a writ of certiorari should be denied.

Respectfully submitted.

ERWIN N. GRISWOLD,
Solicitor General.

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hangars in this country to accommodate the large wing-spread aircraft then coming into use (Pet. App. 14a; Tr. 33–38, 457–462). Messrs. Rongved and Erwin, who began working together in September 1952 in an effort to fulfill the hangar requirements of the Lockheed Aviation Company, completed the invention shortly thereafter, in the fall of 1952 (Pet. App. 14a; Tr. 40–41). Thus, contrary to petitioner's assertion (*e.g.*, Pet. 3, 13), petitioner's invention did not solve a long-standing problem which other inventors had failed to resolve.

Nor is there any factual basis for petitioner's claim (*e.g.*, Pet. 6) that the invention was "revolutionary." As the court found, petitioner's structure was in all respects identical to prior structures, with the "small" difference that the rigid means suspending the truss was specifically designed to withstand compression as well as tension (Pet. App. 8a).

In contrast to the portions of the opinion of petitioner's expert, Professor Fox, quoted in the petition (Pet. App. 24a–33a), the government's expert, Dr. Hechtman, authoritatively testified as to the obvious nature of the claimed invention (Tr. 177 *et seq.*). Indeed, inventor Erwin himself admitted that, after the stress analysis based on the line drawing (see *supra*, n. 3), it became "obvious" to utilize a suspending member capable of withstanding compression as well as tension (Tr. 841).

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